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U.S. Application No. 09/963,483 Art Unit 2155
Response to January 19, 2005 Office Action

REMARKS

In response to the Office Action dated January 19, 2005, the Assignee respectfully requests reconsideration based on the above claim amendments and the following remarks. Assignee respectfully submits that the pending claims distinguish over the cited documents of record.

The United States Patent and Trademark Office (the "Office") rejected claims 1-6, 8-9, and 12-24 under 35 U.S.C. § 102 (e) as being anticipated by U.S. Patent 6,212,265 to Duphorne. The Assignee shows, however, that the pending claims are not anticipated by *Duphorne*. The Assignee thus respectfully submits that the pending claims distinguish over the cited document.

Rejection of Claims 12 & 13

This response will first discuss claims 12 and 13. These claims were rejected under 35 U.S.C. § 102 (e) as being anticipated by U.S. Patent 6,212,265 to Duphorne. A claim is anticipated only if each and every element is found in a single prior art reference. *See Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q. 2d (BNA) 1051, 1053 (Fed. Cir. 1987). *See also* DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2131 (orig. 8th Edition) (hereinafter "M.P.E.P."). As the Assignee shows, claims 12 and 13, in their original form, already distinguish over *Duphorne*. Because *Duphorne* cannot anticipate claims 12 and 13, Examiner Won has no cause for the next office action to be a final rejection.

Duphorne does not anticipate claims 12 and 13. These claims, in their original form, include features not taught or suggested by *Duphorne*. Claim 12, for example, recites "*sending an instruction from the application server to the shared broadband appliance based on the internet protocol address, said instruction including at least the user name and directing the broadband appliance to display a notice directed to the user name.*" The patent to *Duphorne* is completely silent to such features. Examiner Won cites column 4, lines 8-13, column 8, lines 8-

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41, and FIG. 7 as teaching these features. Examiner Won, however, is respectfully mistaken. It's important for Examiner Won to realize that claim 12's instruction is sent i) from the application server ii) to the shared broadband appliance and includes iii) at least the user name and iv) directs the broadband appliance to display a notice directed to the user name. Examiner Won, however, attempts to combine two separate messages discussed by *Duphorne*. The first cited passage discusses "a preliminary email notification signal [transmitted] to the central office." U.S. Patent 6,212,265 to Duphorne (Apr. 3, 2001) at column 4, lines 8-10. The second passage cited by Examiner Won discusses "email notification signals appearing at the input terminal of the email notification device." *Duphorne* at column 8, lines 8-9. The remaining lines of column 8 cited by Examiner Won discuss a processor and other circuitry of Duphorne's email notification device. So, the cited passages fail to teach or suggest an instruction sent i) from the application server ii) to the shared broadband appliance and includes iii) at least the user name and iv) directs the broadband appliance to display a notice directed to the user name.

Duphorne, then, cannot anticipate the claims. The two separate messages cited by Examiner Won (one message sent to a central office and a second message sent to an email notification device) fail to teach or suggest "*sending an instruction from the application server to the shared broadband appliance based on the internet protocol address, said instruction including at least the user name and directing the broadband appliance to display a notice directed to the user name.*" Because *Duphorne* is completely silent to such features, the patent to *Duphorne* cannot anticipate the claims 12 and 13. The Assignee, then, respectfully requests that Examiner Won remove the 35 U.S.C. § 102 (e) rejection.

Rejection of Remaining Claims under 35 U.S.C. § 102 (e)

The United States Patent and Trademark Office (the "Office") rejected the remaining independent claims 1, 14, and 19, and the associated dependent claims, under 35 U.S.C. § 102 (e) as also being anticipated by U.S. Patent 6,212,265 to Duphorne. Independent claims 1, 14, and 19, however, have been amended to distinguish over *Duphorne*. The patent to *Duphorne* does

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not anticipate the amended claims, so the Assignee respectfully requests that Examiner Won remove the 35 U.S.C. § 102 (e) rejection.

Independent claims 1, 14, and 19 have been amended. The independent claims recite distinctive notifications of email arrivals. Independent claim 1, for example, recites "*retrieving a distinctive ring tone from multiple ring tones associated with the directory number, the distinctive ring tone selected by the email addressee to provide a distinct notification despite different email addresses associated with the directory number.*" Support for such features may be found at least at paragraphs [0015], [0016], [0017], and [0025]. Claim 1 is reproduced below, and independent claims 14 and 19 include similar features.

1. (Currently Amended) A method for delivering a distinctive notification of an email arrival to a telephone customer premises equipment, said method comprising:

receiving a message on an application server, said message including at least an email addressee;

looking up the email addressee in a database to identify at least a subscriber directory number associated with the email addressee;

retrieving a distinctive ring tone from multiple ring tones associated with the directory number, the distinctive ring tone selected by the email addressee to provide a distinct notification despite different email addresses associated with the directory number;

sending an instruction from the application server to a service control point, said instruction including at least the subscriber directory number and the distinctive ring tone;

causing an advanced intelligent network node to initiate a call to the subscriber directory number; and

sending a signal to the telephone customer premises equipment to provide the distinctive notification to the email addressee of the email arrival.

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Duphorne does not anticipate such features. Examiner Won is correct — *Duphorne* describes a “special ringing signal [that] is periodically provided to the user’s telephone.” U.S. Patent 6,212,265 to Duphorne (Apr. 3, 2001) at column 10, lines 15-24. No where, however, does *Duphorne* contemplate multiple ring tones associated with a single directory number. As the claims recite, “*the distinctive ring tone [is] selected by the email addressee to provide a distinct notification despite different email addresses associated with the directory number.*” So, while *Duphorne* does mention a “special ringing signal,” no where does *Duphorne* realize that multiple users, and thus multiple ring tones, may be associated with a single directory number.

The Assignee must also strongly disagree with Examiner Won. Examiner Won states that *Duphorne*’s “preferred email notification signal format” (column 4, line 44) fully teaches distinctive ring tones for email notifications. When column 4 of *Duphorne* is completely read, one sees that *Duphorne* fails to make any mention of distinctive ring tones associated with the email addressee. Any assertion that *Duphorne*’s “preferred email notification signal format” encompasses distinctive ring tones is complete speculation.

As *Duphorne* explains, the “preferred email notification signal format” is an entry in each user’s notification parameter database. The “user notification parameter database 14c stores information relative to the user’s 18 email service.” *Duphorne* at column 4, lines 33-35. “Preferably, each user whom subscribes to an email notification service in accordance with the present invention has assigned thereto a line entry in the user notification parameter database.” *Id.* at column 4, lines 35-38. Each user’s line entry contains “the user’s ISP email server Internet address, the user’s username and password, and other control information such as, for instance, parameter values indicating whether the above-mentioned query software is to query the user’s ISP email server, the frequency with which the user’s ISP email server is queried, *preferred email notification signal format*, spam filtering information, and/or other filtering information such as, for instance, particular usernames and/or domain names from which the user does not wish to receive email notification.” *Id.* at column 4, lines 38-47.

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FIG. 2 of *Duphorne* shows an example of a line entry. As *Duphorne* explains, the line entry includes various data fields for accessing an email server and for configuring email notifications. Below is reproduced the entire passage of that explains *Duphorne*'s "preferred email notification signal format." When this passage is carefully read, no where does *Duphorne*'s "preferred email notification signal format" teach or suggest distinctive ring tones.

The line entry 24 includes authentication fields 26a-26c for storing the user 18's email service authentication information and preference fields 28a-28d for storing the user 18's preference parameters. The address field 26a stores the Internet address of the ISP email server 16a, e.g., "mail.server.com", the username field 26b stores the user 18's username, e.g., "BobJones", and the password field 26c stores the user 18's email password, e.g., "fooBAR". The query initiate field 28a indicates whether the above-mentioned query software queries the ISP email server 16a, e.g., "Y"; the query frequency field 28b indicates the frequency with which the ISP email server 16a is queried, e.g., "4.0" hours; the text line field 28c indicates the number of text lines of each email message is to be included in the email notification signal; the message preference field 28d indicates the identity and desired transmission order of email header information, e.g., "Date, Time, Subject, Message"; and the filtering field 28e indicates those email sources from which the user 18 does not desire email notification in accordance with the present invention, e.g., email from "aol.com", email having a subject including the term "sex", and/or email messages that include either of the words "sex" and "xxx". In other embodiments, additional fields may be added as desired.

Duphorne at column 4, line 48 through column 5, line 7. No where does the above passage teach or suggest distinctive ring tones associated with the email addressee. No where does *Duphorne* describe "retrieving a distinctive ring tone from multiple ring tones associated with the directory number, the distinctive ring tone selected by the email addressee to provide a distinct notification despite different email addresses associated with the directory number," as claims 1, 14, and 19 recite. *Duphorne* fails to provide any textual support for distinctive ring tones associated with each email addressee. Any assertion that *Duphorne*'s "preferred email notification signal format" encompasses distinctive ring tones is complete speculation.

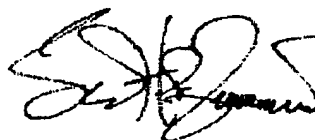
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Duphorne, then, cannot anticipate claims 1, 14, and 19. Because *Duphorne* is completely silent to such distinctive ring tone features, the patent to *Duphorne* cannot anticipate the claims 1, 14, and 19. The Assignee, then, respectfully requests that Examiner Won remove the 35 U.S.C. § 102 (e) rejection.

If any questions arise, the Office is requested to contact the undersigned at (919) 387-6907 or scott@scottzimmerman.com.

Respectfully submitted,



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